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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,413	11/21/2000	Owen H. Decker	FA0972 US NA	6493

23906 7590 08/14/2003

E I DU PONT DE NEMOURS AND COMPANY  
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WILMINGTON, DE 19805

EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 08/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/717,413

Applicant(s)

DECKER ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

-- Th MAILING DATE of this communication appears on th cov r sheet with th corr spond nc addr ss --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. All outstanding rejections except for those described below are overcome by applicants' amendment filed 5/27/03.

**Claim Rejections - 35 USC § 112**

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-2 and 5-7 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The rejection is adequately set forth in paragraph 3 of the office action mailed 1/21/03, Paper No.9, and is incorporated here by reference.

**Response to Arguments regarding 35 USC 112 rejection of record**

4. Applicants' arguments filed 5/27/03 have been fully considered but they are not persuasive.

Previously, examiner argued that the phrases "gloss value is decreased by at least twice as much as a coating composition comprising 0 wt.% of spheroidal particles" and "flow parameters are decreased by no more than 1.5 times as much as a coating composition comprising 0 wt.% of spheroidal particles" failed to satisfy the written description requirement

under the 35 USC 112, 1<sup>st</sup> paragraph since there does not appear to be a written description requirement of either phrase in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163.

Applicants have responded by amending claims 1 and 5 to each recite that the “low gloss powder coating composition has a gloss value that is from about 2 to about 3 times less than a powder coating composition comprising 0 wt.% spheroidal particles” and that the “low gloss powder coating composition has flow parameters that are decreased by no more than from about 0 to about 3 times as much as a powder coating composition comprising 0 wt.% spheroidal particles”. Applicants also argue that, contrary to examiner’s previous position that there is only support for the recitation of each of the expressly disclosed embodiments as set forth in Table 9, an applicant satisfies the written description requirement by conveying “with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention in that context is whatever is now claimed” and that in conformity with the written description requirement as set forth in MPEP 2163, applicants are claiming that which was actually reduced to practice in examples 1-19; examples that were part of the specification as originally filed.

While applicants state that the recitation regarding the decrease in gloss and flow parameter of the presently claimed powder coating composition as compared to powder coating composition comprising 0 wt.% spheroidal particles is based on examples 1-19, it is noted that not all the examples utilize spheroidal particles with median particle diameter and maximum particle diameter as required in all the present claims (examples 5-7 and 9-13) and thus, these examples would not provide support for a recitation regarding the decrease in gloss and flow

parameter when utilizing spheroidal particles of the claimed median particle diameter and maximum particle diameter. Further, excluding the control examples which contain no spheroidal particles (examples 1, 14, 16, and 18), the recitation regarding the decrease in gloss and flow parameter of the presently claimed powder coating composition as compared to powder coating composition comprising 0% spheroidal particles would be based on examples 2-4, 8, 15, 17, and 19. Thus, examples 2-4, 8, 15, 17, and 19 disclose gloss value which is 1.4, 2.0, 2.7, 2.9, 2.6, 2.1, 2.7, and 3.2 times less, respectively, than gloss value of powder coating composition comprising 0% spheroidal particles, while examples 2-4, 8, 15, 17, and 19 disclose flow parameter which is 1.1, 1.2, 1.5, 1.7, 1.5, the same, 2.6, and 1.2 times less, respectively, than the flow parameter of powder coating composition comprising 0% spheroidal particles.

Based on these examples, it is the examiner's position that applicants were not in possession of the invention as presently claimed and that applicants are claiming more than what was reduced to practice in the examples. Specifically, the recitation that the gloss is from "about 2 to about 3 times less" than powder coating composition comprising 0 wt.% spheroidal particles is not supported in the examples as described above. The phrase "about 2 to about 3 times less", especially in light of the use of the phrase "about" which includes values slightly above and below that which is explicitly claimed, encompasses gloss values such as 1.3, 1.35, 3.25, 3.3, etc. for which there is no support in the specification as originally filed. Similarly, it is the examiner's position with respect to the flow parameters that the recitation that the flow parameters are decreased by no more than "from about 0 to about 3 times as much" as powder coating composition comprising 0 wt.% spheroidal particles is not supported in the examples as

described above. The recitation of “about 3 times” includes values such as 2.8, 3.1, etc. for which there is no support in the specification as originally filed.

**NOTE:** If applicants were to amend claims 1 and 5 to recite that “said low gloss powder coating composition has a gloss value that is from 1.4 to 3.2 times less than a powder coating composition comprising 0 wt.% of spheroidal particles” and “said low gloss powder coating composition has flow parameters that are decreased by no more than from about 0 to 2.6 times as much as a powder coating composition comprising 0 wt.% of spheroidal particles”, support for such phrases which is found in the examples as described above, the examiner would be willing to remove the above rejection.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Phillips (U.S. 6,524,694) disclose powder coating composition comprising thermoplastic polymer and particulate wherein the particulate includes ceramic microspheres and glass microsphere. The particulates possess average maximum particle diameter of 0.1-200 microns and have particle diameter of, for instance, 10-100 microns. However, there is no disclosure of median particle diameter as required in the present claims or any disclosure regarding the flow parameters. Further, the examples utilize glass microspheres, namely Zeeospheres W400 and W610, which as disclosed in the present specification, each possess median particle diameter and maximum particle diameter outside the scope of the present claims.

WO 00/01774 discloses powder coating composition comprising film-forming polymer and gloss-reducing agent, however, there is no disclosure of spheroidal particles and no

disclosure of spheroidal particles that possess maximum particle diameter of about 50 microns as presently claimed.

GB 2,231,334 discloses powder coating composition comprising thermosetting or thermoplastic polymer and spherical polymer granules, however, there is no disclosure of the maximum particle diameter of the granules and no disclosures regarding gloss or flow parameters as presently claimed.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

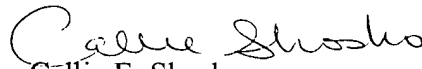
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
Callie E. Shosho  
Primary Examiner  
Art Unit 1714

CS  
August 9, 2003